



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUL | 2003

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In re Application of :
John F. Chiarello et al :
Serial No.: 09/921,188 : PETITION DECISION
Filed: August 2, 2001 :
Attorney Docket No.: AM200074-00 :

This is a decision on the petition under 37 CFR 1.144, filed March 7, 2003, requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained 11 claims. A first examiner assigned to the application mailed a first Office action to applicants on November 15, 2002, setting forth a restriction requirement as follows:

- Group I, claims 1-9, drawn to a process for producing a chiral compound and the chiral compound *per se*;
- Group II, claims 10-11, drawn to a (different) chiral compound.

The examiner reasoned that Groups I and II were mutually exclusive species in an intermediate-final product relationship and that they were separate and distinct species, each having a utility and that the intermediate could be used to make other products. The examiner also stated that Groups I and II were related as product and process of use and that the process could be practiced with other products. Claim 11 was also indicated as directed to patentably distinct species and an election of species was required.

Applicants replied on December 16, 2002, electing Group I with traverse as to Group II based on the criteria that the examiner had not met the criteria for restriction. Specifically since the classification of the Groups significantly overlap, no serious burden is placed on the examiner to examine all claims. Further, the examiner was cited as not having met the burden of two-way distinctness for restriction between intermediate and final product..

The application was then transferred to a new examiner in a different Art Unit and the new examiner mailed an Office action to applicants on February 12, 2003. The examiner maintained

the restriction requirement stating that the examiner burden may be shown by different classification, separate status in the art or different search and that applicant had not provided evidence rebutting any of these criteria. The examiner also stated that the intermediate final product distinctness is shown by the intermediate being described as an insecticide in Elliott (4,137,324). The examiner made the requirement Final. The examiner then indicated claims 1-9 allowable

Applicants filed this petition on March 7, 2003, traversing the examiner's holding for essentially the same reasons as before.

DISCUSSION

Applicants recite the legal standard for restriction as set forth in 35 U.S.C. 121 and 37 CFR 1.142 protesting that the Office incorrectly interprets the statute which requires that inventions be independent and distinct (emphasis by applicants) by stating that the Office only requires that the inventions be independent or distinct (emphasis by applicants). However, applicants' argument has not been supported by any judicial authority and Office practice remains as stated. The only exception to this practice is where intermediates and final products are concerned.

With respect to the examiner's evidence of separate and independent utility of the intermediate applicants state that the reference used (Elliott) shows an intermediate which has insecticidal properties only when combined with chrysanthemic acid or other components. Thus the reference does not show the same compounds as intermediates and having a utility by themselves. Applicants are correct in their assertion. The intermediates of Group II claimed by applicants are not those of Elliott.

With respect to the burden on the examiner to examine all claims, applicants state that the examiner has failed to show any serious burden. Notably, the two Groups of claimed compounds are classified generally in the same classes and subclasses. Applicants complain that the examiner's use of "subclass various" masks, rather than demonstrates, differing classifications. Nor has the examiner shown any burden by showing a significantly different search or recognition in the art of separate status. Applicants are correct that the examiner has not met the criteria to show a serious burden on the examiner to examine all of the compounds.

In view of the above arguments by applicants and also in view of the fact that claims 6-9 are indicated as intermediates as are claims 10-11 (although in different parts of the reaction sequence), and that both intermediates contain the same chiral center, rejoinder of claims 10-11 with claims 1-9 is appropriate.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED**. Claims 1-11 will be examined together.

In view of the fact that the last Office action only finalized the restriction requirement and indicated the elected claims allowable and required cancellation of non-elected subject matter, and this decision withdraws the restriction requirement and voids the requirement to cancel non-elected subject matter, the last Office action is withdrawn. No reply thereto is required of applicants.

The application will be forwarded to the examiner for further consideration not inconsistent with this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

A handwritten signature in black ink, appearing to read "Bruce M. Kisliuk", with a stylized, cursive script.

Bruce M. Kisliuk
Director, Technology Center 1600